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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Toshiaki Ito

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12/15/2003

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EXAMINER

FORMAN, BETTY J

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/879,797

Applicant(s)

ITOH ET AL.

Examiner

BJ Forman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**FIANL ACTION**

***Status of the Claims***

1. This action is in response to papers filed 25 September 2003 in which claims 4-6 were amended and claims 7-13 were canceled. All of the amendments have been thoroughly reviewed and entered. The previous rejections in the Office Action dated 26 June 2003 are withdrawn in view of the amendments. All of the arguments have been thoroughly reviewed but are deemed moot in view of the amendments, withdrawn rejections and new grounds for rejection. New grounds for rejection necessitated by amendment are discussed.

Claims 4-6 are under prosecution.

***Priority***

*Reiterated from previous office action*

2. Applicant's claim for domestic priority under 35 U.S.C. 120 is acknowledged. However, the Parent Application 09/451,666 filed 30 November 1999 upon which priority is claimed does not provide adequate support under 35 U.S.C. 112 for claim 6 of this application because the '666 application does not teach a v-shaped notch. Therefore, the effective filing date for instant claim 6 is the filing date of the instant application i.e. 11 June 2001.

The parent application also does not provide adequate support for new claim 10 drawn to two V-shaped notches crossing each other. Therefore, the effective filing date for instant claims 6 and 10 is the filing date of the instant application i.e. 11 June 2001.

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***Specification***

3. The amendment filed 25 September 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Paragraph 33 has been amended at lines 4-5 and 10-11 to recite "the groove has a width and a depth shorter than the head end width". This description of the spotting pin was not recited or illustrated in the originally filed disclosure. Figure 6 illustrates various spotting pins, but the illustration does not provide dimensions of the grooves. Furthermore, neither the illustrations or the specification define any dimensional relationship between the groove and the head of the pin. Therefore, the newly added recitations introduce new matter into the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claims 4-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The recitation "the groove has a width and a depth shorter than the head end width" is added to the newly amended claims. However, the specification fails to define or provide any disclosure to support such claim recitation.

MPEP 2163.06 notes "IF NEW MATTER IS ADDED TO THE CLAIMS, THE EXAMINER SHOULD REJECT THE CLAIMS UNDER 35 U.S.C. 112, FIRST PARAGRAPH - WRITTEN DESCRIPTION REQUIREMENT. *IN RE RASMUSSEN*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)." MPEP 2163.02 teaches that "Whenever the issue arises, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed...If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application." MPEP 2163.06 further notes "WHEN AN AMENDMENT IS FILED IN REPLY TO AN OBJECTION OR REJECTION BASED ON 35 U.S.C. 112, FIRST PARAGRAPH, A STUDY OF THE ENTIRE APPLICATION IS OFTEN NECESSARY TO DETERMINE WHETHER OR NOT "NEW MATTER" IS INVOLVED. APPLICANT SHOULD THEREFORE SPECIFICALLY POINT OUT THE SUPPORT FOR ANY AMENDMENTS MADE TO THE DISCLOSURE" (emphasis added).

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Augsburg (U.S. Patent No. 4,652,188, issued 24 March 1987).

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The claims are drawn to a pin having the following structural requirements:

Claim 1 requires a solid member, having a recess only at a cylindrical head end, said head end being recessed wherein the recess is concave and comprises a cross-shaped groove and wherein the groove has a width and depth shorter than the head end width.

Claim 2 requires a solid member having a recess formed only at a head end wherein the recess is a cross-shaped groove and wherein the groove has a width and depth shorter than the head end width.

Claim 3 requires a solid member having a recess formed only at a cylindrical head end wherein the recess comprises two V-shaped notches crossing each other at right angles.

The functional language e.g. "spotting", "to spot", "to carry" do not define or describe the structural components of the pin.

The courts have stated that claims drawn to an apparatus must be distinguished from the prior art in terms of structure rather than function see *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525,1528 (Fed. Cir. 1990) (see MPEP, 2114).

7. Regarding Claim 4-6, Augsburg teaches the claimed pin (see especially Fig. 4) comprising a solid member having a cylindrical head end, with a recess consisting of cross-shaped groove (two V-shaped notches crossing at right angles) and wherein the groove has a width and depth shorter than the head end (i.e. shallow notch) (Column 2, line 54-Column 3, line 41).

Because the courts have stated that a device must be defined over the prior art in terms of structure and because Augsburg teaches the claimed structure, the instantly claimed pins are not distinguished over the pins of Augsburg.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lough et al (WO 98/20019, published 14 May 1998).

Regarding Claims 4-6 Lough et al teach a spotting pin comprising a solid member wherein the solid member has at least one recess at a tip thereof (page 19, lines 11-12 and 15-17 and Fig. 9a, 9b, and 9c) and they teach the tip comprises "any number of configurations" (page 19, lines 15-16) but they do not specifically teach the recess comprises at least one groove (Claim 4); a cross-shaped groove (Claim 5); at least one V-shaped notch (Claim 6); a cross-shaped groove (Claim 8); a flat tip with a cross-shaped groove (Claim 9 and 11); and two V-shaped notches crossing each other (Claim 10 and 13).

The courts have stated that absent evidence to the contrary; a particular configuration of a known device is a matter of choice which would have been obvious to one skilled in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Therefore, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the tip configuration of Lough et al based on their teaching wherein the pin can be of "any number of configurations" (page 19, lines 15-16) for the obvious benefits of optimizing pin configuration for desired spotting results as suggested by Lough (page 22, lines 10-17).

10. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Little et al (U.S. Patent No. 6,347,259, filed 1 April 1999).

Regarding Claims 4-6 and 8-13, Little et al teach a spotting pin comprising a solid member wherein the solid member has at least one recess at a tip thereof (Column 50, lines 39-50) and they teach the tip comprises "any number of configurations" (page 19, lines 15-16) but they do not specifically teach the recess comprises at least one groove (Claim 4); a cross-shaped groove (Claim 5); at least one V-shaped notch (Claim 6); a cross-shaped groove (Claim 8); a flat tip with a cross-shaped groove (Claim 9 and 11); and two V-shaped notches crossing each other (Claim 10 and 13).

The courts have stated that absent evidence to the contrary; a particular configuration of a known device is a matter of choice which would have been obvious to one skilled in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Therefore, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the tip configuration of Little et al based on their teaching wherein the pin can be of "any number of configurations" (Column 50, lines 39-55) for the obvious benefits of optimizing pin configuration for desired spotting results as suggested by Little (Column 51, line 65-Column 52, line 3).

### **Response to Arguments**

11. Applicant argues that the pins of Lough et al and Little have recesses with a depth and width significantly longer than the head end width and therefore do not meet the requirements of the instant claims. The argument has been considered. However, the rejections are maintained in view of the New Matter rejection discussed above.



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12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### Conclusion

13. No claim is allowed.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878 until 13 January 2004. Starting 14 January 2004, the examiner's phone number will be (517) 272-0741. The examiner can normally be reached on 6:00 TO 3:30 Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



BJ Forman, Ph.D.  
Primary Examiner  
Art Unit: 1634  
December 11, 2003